



K05A0627 (WESDIG.020A)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Russell M. Krapf
Appl. No.	:	09/608,819
Filed	:	June 30, 2000
For	:	SYSTEM FOR DISPLAYING VIDEO DATA HAVING A PROMOTION MODULE RESPONSIVE TO A VIEWER PROFILE TO ENTICE A VIEWER TO WATCH A PREMIUM CONTENT
Examiner	:	Ngoc K. Vu
Group Art Unit:	:	2623

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicant requests a pre-appeal brief review of the legal and factual basis of the rejections in the September 18, 2006 Final Office Action. No amendments are being filed with this request, and this request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheets.

Appl. No. : 09/608,819
Filed : June 30, 2000

REASONS FOR THE REQUESTED REVIEW

In the September 18, 2006 Final Office Action, the Examiner rejected Claims 1-4, 6-18, and 20-27 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of prior art references. In the January 19, 2007 Advisory Action, the Examiner reaffirms these rejections.

Response to Rejection of Claims 1-4, 6, 10-12, 14-18, and 20-27 Under 35 U.S.C. § 103(a)

In the September 18, 2006 Office Action, the Examiner rejects Claims 1-4, 6, 10-12, 14-18, and 20-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0029610 of Corvin et al. ("Corvin") in view of U.S. Patent Application Publication No. 2002/0056099 of Takahashi et al. ("Takahashi"). In view of the following discussion, Applicant respectfully traverses this rejection.

Claim 1

Applicant submits that Claim 1 includes limitations that are not disclosed or suggested by either Corvin or Takahashi. For example, neither Corvin or Takahashi disclose or suggest a promotion module which causes "the selected at least one preferred promotion content to be retrieved from the local storage device and displayed to entice the viewer to select for viewing previously locally stored premium content associated with the selected at least one preferred promotion content" as recited by Claim 1.

Corvin discloses a system for providing promotions with recorded programs by recording selected promotions with the recorded programs or by inserting selected promotions into a recorded program as it is played back (*see*, abstract and paragraphs 0026-0027 of Corvin). While Corvin discloses that these promotions can include movie previews (*see, e.g.*, Corvin at paragraph 0006), Applicant submits that Corvin does not disclose or suggest that these movie previews correspond to previously locally stored programs. For example, when an inserted promotion is played back while playing back a previously recorded program, the promotion can not entice the viewer to select the previously recorded program since the viewer is already watching this program. The promotion which is played back in Corvin may entice the viewer to select and watch programs or movies other than the recorded program the viewer is watching, however Corvin does not disclose or suggest that this other program is itself locally stored previously. Therefore, display of the selected promotion as taught by Corvin does not entice the viewer to select previously locally stored premium content for viewing. Thus, Corvin does not disclose or suggest a promotion module which causes the selected preferred promotion content to

Appl. No. : 09/608,819
Filed : June 30, 2000

be displayed “to entice the viewer to select for viewing previously locally stored premium content associated with the selected at least one preferred promotion,” as recited by Claim 1 (emphasis added).

Takahashi discloses an information processing apparatus and method which stores promotion programs which correspond to ordinary programs to be subsequently broadcasted from a head end and the promotion programs are displayed as part of an electronic program guide (EPG). Thus, Takahashi does not disclose or suggest a promotion module which causes the selected preferred promotion content to be displayed “to entice the viewer to select for viewing previously locally stored programs,” as recited by Claim 1 (emphasis added).

The Examiner asserts that Claim 1 includes “intended use limitations,” namely “to entice the viewer to select for viewing previously locally stored premium content associated with the selected at least one preferred promotion content” and states that Corvin discloses structure capable of performing the intended use. Applicant respectfully traverses this assertion.

Features of an apparatus may be recited functionally. See, M.P.E.P. § 2114, 2173.05(g). Such functional claim language which contains a recitation of the manner in which the apparatus is intended to be employed can differentiate the claim from the prior art if the functional claim language fairly conveys structural differences between the apparatus and the prior art to persons skilled in that art.

Applicant submits that the “intended use limitations” cited by the Examiner convey to persons skilled in the art structural differences between the apparatus recited by Claim 1 and the teaching of Corvin. For example, the present application at page 6, lines 2-12 discloses an embodiment in which “the personal video recorder 20 may then pre-record a plurality of premium contents with assigned promotional materials” and “the control device 10 may display at least one of the corresponding promotion contents 8 randomly during the present viewer’s viewing session to entice the present user to watch one of the pre-recorded premium contents.” Persons skilled in the art would understand from this and other portions of the present application that the video system recited by Claim 1 includes information regarding what premium content is locally stored and structure that accesses the information to select promotional content to display so as to entice a viewer to watch the previously locally stored premium content. Corvin does not teach or suggest such features, so the video system recited by Claim 1 is structurally different from the structure disclosed by Corvin.

Appl. No. : **09/608,819**
Filed : **June 30, 2000**

Because neither Corvin nor Takahashi discloses or suggests “a promotion module ... to cause the selected at least one preferred promotion content to be retrieved from the local storage device and displayed to entice the viewer to select for viewing previously locally stored premium content,” as recited by Claim 1, Applicant submits that Claim 1 is patentably distinguished over the combination of Corvin and Takahashi.

Claims 2-4, 6, 10-11, and 24-25

Claims 2-4, 6, 10-11, and 24-25 depend from Claim 1, so Claims 2-4, 6, 10-11, and 24-25 include all the limitations of Claim 1 as well as other limitations of particular utility. Therefore, for at least the reasons discussed above in regard to Claim 1, Claims 2-4, 6, 10-11, and 24-25 are patentably distinguished over Corvin and Takahashi.

Claim 12

For reasons similar to those described above with respect to Claim 1, Applicant submits that Claim 12 includes limitations not taught or suggested by the combination of Corvin in view of Takahashi. Applicant therefore submits that Claim 12 is patentably distinguished over the cited prior art.

Claims 14-18, 20-23, and 26-27

Claims 14-18, 20-23, and 26-27 depend from Claim 12, so Claims 14-18, 20-23, and 26-27 include all the limitations of Claim 12 as well as other limitations of particular utility. Therefore, for at least the reasons discussed above in regard to Claim 12, Claims 14-18, 20-23, and 26-27 are patentably distinguished over Corvin and Takahashi.

Response to Rejection of Claims 7-9 Under 35 U.S.C. § 103(a)

In the September 18, 2006 Office Action, the Examiner rejects Claims 7-9 under 35 U.S.C. §103(a) as being unpatentable over Corvin in view of Takahashi, and further in view of U.S. Patent No. 6,590,979 issued to Ryan (“Ryan”).

As discussed above, Corvin and Takahashi do not disclose or suggest all the limitations of Claim 1. Applicant submits that Ryan does not disclose or suggest the limitations of Claim 1 missing from Corvin in view of Takahashi. Therefore, Applicant submits that Claim 1 is patentably distinguished over Corvin in view of Takahashi and further in view of Ryan.

Each of Claims 7-9 depends from Claim 1, so each of Claims 7-9 includes all the limitations of Claim 1 as well as other limitations of particular utility. Therefore, Claims 7-9 are each patentably distinguished over the cited prior art.

Appl. No. : 09/608,819
Filed : June 30, 2000

Response to Rejection of Claim 13 Under 35 U.S.C. § 103(a)

In the September 18, 2006 Office Action, the Examiner rejects Claim 13 under 35 U.S.C. §103(a) as being unpatentable over Corvin in view of Takahashi, and further in view of U.S. Patent Application Publication No. 2003/0131356 of Proehl et al. ("Proehl").

As discussed above, Corvin and Takahashi do not disclose or suggest all the limitations of Claim 12. Applicant submits that Proehl does not disclose or suggest the limitations of Claim 12 missing from Corvin in view of Takahashi. Therefore, Applicant submits that Claim 12 is patentably distinguished over Corvin in view of Takahashi and further in view of Proehl.

Claim 13 depends from Claim 12, so Claim 13 includes all the limitations of Claim 12 as well as other limitations of particular utility. Therefore, Claim 13 is patentably distinguished over the cited prior art.

Summary

For the reasons stated above, Applicant submits that Claims 1-4, 6-18, and 20-27 are in condition for allowance, and Applicant respectfully requests such action.

Dated: 2/19/07

Respectfully submitted,

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